

REMARKS

Summary of the Office Action

1. Figures 18-19 were not accepted by the Examiner because they introduced new matter.
2. The drawings are objected under 37 CFR 1.83(a), as the drawings must show every feature of the invention specified in the claims.
3. The specification are objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure.
4. Claims 48-49 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
This rejection has been addressed by amendment.
5. Claims 19-26 and 45-50 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
6. Claims 22 and 23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Detailed Remarks

1. FIG. 18 and FIG. 19 Not Accepted

Applicant requests entry of these Figures. In not accepting these drawings, the Examiner has stated that elements 110 and 120 seemed to be shown as being the same element or integrated. Respectfully this is not the case. FIG. 18 and 19 mirror FIG. 1 and 2. The description accompanying FIG. 18 and 19 makes specific reference to being similar to “embodiments described above”, which would include FIG. 1 and FIG. 2. One would have to make an inference from FIG. 18 and 19 that elements 110 are the same, and this inference would not be supported by the Specification.

The Examiner also states that FIG. 18 and FIG. 19 appear deformable or stretched. Respectfully, this is an interpretation and not reflected by the

Specification. FIG. 18 and FIG. 19 merely mirror FIG. 1 and FIG. 2, consistent with the description in the specification.

2. The drawings are objected under 37 CFR 1.83(a), as the drawings must show every feature of the invention specified in the claims.

Applicant requests reconsideration in view of the remarks presented in the preceding paragraph.

3. The specification are objected to under 35 U.S.C. § 132(a) because it introduces new matter into the disclosure.

Applicant questions the applicability of the statute. But Applicant understands the rejection to be one that is based on the figures not having been accepted. Accordingly, Applicant requests reconsideration, as it is Applicant's arguments that the figures should be entered.

4. Claims 48-49 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection has been addressed by amendment.

5. Claims 19-26 and 45-50 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The Examiner has premised this rejection on there being "merely...a SINGLE paragraph) regarding the embodiment..."

First, it appears that Applicant and Examiner agree that there is a description of the claimed embodiment in the Specification:

But respectfully, the Examiner is incorrect in stating that there is "merely a SINGLE paragraph regarding the embodiment." This paragraph provides a descriptive variation to prior embodiments, and the paragraph does not exist in a vacuum without context of preceding description. Specifically, the paragraph in question expressly states that the embodiment described in the paragraph has a "similar configuration" to other "embodiments described above." This clearly satisfies the legal requirement for satisfying the written description requirement,

as summarized in the MPEP 2163: "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116."

Second, even if one was to accept the assertion that only one paragraph of description exists for the claimed embodiment, there is absolutely no legal authority for the proposition that an applicant is precluded from claiming subject matter if it is only mentioned in one paragraph of a specification.

Third, the Examiner states the *disclosure* (i.e. the single paragraph) is insufficient because the disclosure does not explicitly disclose "what embodiments may provide or may not provide for a similar configuration to be used for a variation in a width of a handheld computer." Respectfully, this is error. The rejection should be founded on "*the claimed invention*", not on "what embodiments may provide or may not provide for a similar configuration...."

The Examiner also rejects Claim 19 because it recites: "a display assembly accessible on a front surface of the first segment." The rejection is premised that this feature is not described in context of a device "varying its width". This is the same rejection as provide above. Again, the Single Paragraph description provides a descriptive variation of previously described embodiments, one of which includes a "display assembly accessible on a front surface of the first segment." Applicant raises similar arguments with regard to other language the Examiner has alleged lack written description: "a second segment slideably coupled to the first segment ... external to the first segment".

The Examiner also rejects Claim 19 based on the language: "a set of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the extended position and not when in the contracted position." This language has been amended.

The Examiner also rejects Claim 21 because it recites: "wherein all of the

display assembly is accessible to receive contact as input when the second segment is in the extended position.” The rejection is premised that this feature is not described in context of a device “varying its width”. This is the same rejection as provide above. Applicant reiterates the arguments made above.

The Examiner also rejects Claim 22 because it recites: “wherein the display assembly includes an immediate character recognition section configured to immediately recognize and display a character entry, and wherein a portion of the display assembly that is overlaid b the first segment includes the immediate character recognition section.” Applicant reiterates the arguments made above.

The Examiner also rejects Claim 23 because it recites: “wherein the display assembly includes a first section having a cross-section comprising a digitizer pad and a screen and a second section comprising the digitizer pad without the screen, and wherein a portion of the display assembly that is overlaid by the first segment includes the second section.” Applicant reiterates the arguments made above.

The Examiner rejects Claim 24 because it recites: “a midframe coupled to the first segment and the second segment.” Applicant reiterates the arguments made above.

The Examiner also rejects Claim 25 and Claim 26 because they each recite:” wherein the midframe ... the extended position....” Applicant reiterates the arguments made above.

With regard to Claim 45, the Examiner has formulated the rejection based on the language “a second segment moveably coupled to... in the extended position; so that when the second segment is in the contracted position, the second segment is overlaid and external to the first segment...” Other language forming the rejection to this Claim include “a display assembly provided by the first segment”. As previously argued, Applicant is entitled to have the Single Paragraph description read as a variation to previously described embodiments.

The Examiner also alleges that the language “wherein when the second

segment is in the contracted position... at least one of either the multi-directional mechanism or the display assembly is at least partially blocked" is not described in the Specification in any form (e.g. length-varying embodiment). This is not accurate. Applicant respectfully requests review of the rejection, as the Examiner may have inadvertently cut and paste this portion of the rejection from Claim 19. Claim 45 does not include the language forming Examiner's rejection-this language is used in Claim 19.

Additionally, the Examiner rejects Claim 47 and alleges that the language "wherein the first segment overlays the second segment so that the display assembly covers at least a portion of the one or more of the input mechanism" is not described in the specification in the context of a device "varying its width". This is the same rejection as presented with Claim 19. Applicant thus reiterates the arguments made above.

Additionally, the Examiner rejects Claim 49 and alleges that the language: "wherein the first segment overlays the second segment so that the display assembly covers at least a portion of the one or more of the input mechanism" is not described in the specification in the context of a device "varying its width". This is the same rejection as presented with Claim 19. Applicant thus reiterates the arguments made above.

Similarly, the Examiner rejects Claim 50 and alleges that the language "wherein the second segment is configured to slide towards and away from the first segment" is not described in the specification in the context of a device "varying its width". This is the same rejection as presented with Claim 19. Applicant thus reiterates the arguments made above.

6. Claims 22 and 23 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

These claims have been canceled. Thus, the rejection is moot.

For all of the reasons stated, Applicant submits the pending claims are in condition for allowance.

CONCLUSION

A Notice of Allowance is respectfully requested. If there are any questions or comments that the Examiner wishes to direct to Applicant's attorney, the Examiner is invited to call Applicant's attorney at (408) 551-6632.

If an extension of time is required in connection herewith, applicant hereby petitions for such extension.

Applicant hereby authorizes deposit account 501914 to be charged for any fee due in connection with this submission, including any extension of time fee.

Respectfully submitted,

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